

The opinion in support of the decision being entered today was not written
for publication and is not binding precedent of the Board.

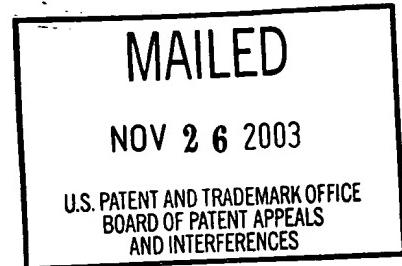
Paper No. 36

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte ALAN G. BARBOUR and
CATHERINE J. LUKE

Appeal No. 2003-1082
Application No. 08/588,637



Before HARKCOM, Acting Chief Administrative Patent Judge, and WINTERS and WILLIAM F. SMITH, Administrative Patent Judges.

WILLIAM F. SMITH, Administrative Patent Judge.

REMAND TO THE EXAMINER

Our consideration of the record leads us to conclude that this case is not in condition for a decision on appeal. Accordingly, we remand the application to the examiner to consider the following issues and take appropriate action.

The examiner entered an Examiner's Answer on August 7, 2002 (Paper No. 28). In response, appellants filed a Reply Brief received at the USPTO on September 3, 2002 (Paper No. 30) that contains Exhibits A-E and a showing under 37 CFR § 1.195.

The examiner issued a "Communication" on December 23, 2002, stating the Reply Brief had been entered and that the case would be forwarded to the board. In entering the Reply Brief, the examiner presumably accepted appellants' showing under 37 CFR § 1.195 and entered and considered the exhibits.

Upon return of the application, the examiner needs to prepare a substantive response to each point contained in the Reply Brief, taking into account the exhibits. Specifically, the examiner should note appellants' concern that the examiner has not cited to specific sections of the Cohen reference relied upon in the extant rejection. See Reply Brief, pages 2-3. Furthermore, while the examiner agreed that appellants' Appeal Brief complied with 37 CFR § 1.192(c)(7) and (c)(8) in presenting arguments for separate patentability of claims pending in this appeal, we do not find the examiner responded to the arguments directed to individual claims set forth in the briefing. Thus, the requested substantive response should be complete and respond to each argument made by appellants.

We state that we are authorizing a Supplemental Examiner's Answer under 37 CFR § 1.193(b)(1) if otherwise appropriate.

REMANDED

Gary V. Harkcom
Administrative Patent Judge

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)

Sherman D. Winters
Administrative Patent Judge

) BOARD OF PATENT

) APPEALS AND

William F. Smith
Administrative Patent Judge

) INTERFERENCES

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Thomas J. Kowalski
Frommer, Lawrence & Haug, LLP
745 Fifth Avenue
New York, NY 10151

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